APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/715,313	11/17/2003	Keith A. Thuerk	BOC9-2003-0033 (402)	5100

40987 7590 07/23/2007	EXAMINER
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ART UNIT	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	10/715,313	THUERK, KEITH A.
	Examiner	Art Unit	
	William J. Goodchild	2145	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>*17 November 2003*</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-35* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-35* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>*17 November 2003*</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

        1.☐ Certified copies of the priority documents have been received.

        2.☐ Certified copies of the priority documents have been received in Application No. _____.

        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>*03/05/2004*</u>.

4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 101

1.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 16-35 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 16-35 can be considered to be software in accordance with applicants specification, (page 14, paragraph 46, "The present invention also can be embedded in a computer program product, which comprises all the features enabling the implementation of the methods described herein, and which when loaded in a computer system is able to carry out these methods."). In order for a claim to be statutory, it must fall within a process, machine, manufacture, or a composition of matter. Software does not fall within a statutory category since it is not a series of steps or acts to constitute a process, not a mechanical device or combination of mechanical devices to constitute a machine, not a tangible physical article or object which is some form of matter to be a product and constitute a manufacture, and not a composition of two or more substances to constitute a composition of matter.

Claim Rejections - 35 USC § 102

2.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3.   Claims 1-2, 6-20 and 24-35 are rejected under 35 U.S.C. 102(b) as being

anticipated by Landon, Deb, Del Valle, Sergio, Piza, Jazmin, Rush, Leif, "Deploying

Lotus Sametime on the eserver iSeries Server", Redbooks, June 2002, (hereinafter

Lotus Sametime).

In reference to claims 1, 19 and 34, Lotus Sametime teaches a method / system

comprising:

providing a collaborative computing system comprising at least one instant

messaging client, (page 2, 1.1, page 65, figure 3-46, Sametime Connect for the

desktop, Exchange messages with AOL Instant Messenger users);

initializing said instant message client within a graphical user interface of said

collaborative computing system, (page 136, 5.2.1);

receiving a search initializing action from said graphical user interface, (page

201, Creating a buddy list and group);

responsive to said receiving step, presenting search input fields within said

graphical user interface, (page 201, figure 6-7);

receiving input via said input fields that specifies a search pattern, (page 201,

figure 6-7 and Creating a buddy list and group);

searching at least one record source for online entities that satisfy said search

pattern, (page 201, step 2-3); and

displaying a search result from said searching step within said graphical user

interface, (page 201, step 2).

In reference to claims 2 and 20, Lotus Sametime teaches the method / system of

claims 1 and 19 wherein:

said collaborative computing system is a Lotus Sametime (TM) type system,

(page 15).

In reference to claims 6 and 24, Lotus Sametime teaches the method / system of

claims 1 and 19 further comprising:

establishing a plurality of user specific search patterns; and recording said

search patterns so that said search patterns can be retrieved at a later time, (page 126,

1st paragraph and figure 4-22, Search filters).

In reference to claims 7 and 25, Lotus Sametime teaches the method / system of

claims 1 and 19 wherein:

said record source comprises a first database that is a record source specifying

at least one online entity and a second database having a data field, wherein said data

field specifies an attribute relating to said online entity that is not specified within said

first database, said searching step further comprising the steps of:

establishing a query that includes said data field; and searching for at least one

online entity using said query, (page 126, figure 4-22, field search filter for resolving

person or groups and table 4-5).

In reference to claims 8 and 26, Lotus Sametime teaches the method / system of

claims 1 and 19 further comprising:

specifying a plurality of record sources, each of which specifies at least one

online entity, wherein said searching step further comprises searching said plurality of

record sources for online entities that satisfy said search pattern, (page 120, table 4-2,

Description of Field "Host Name or IP address of the LDAP server").

In reference to claims 9 and 27, Lotus Sametime teaches the method / system of

claims 8 and 26 further comprising:

establishing at least one search preference that is used when performing said

searching step, wherein said search result is based at least in part upon said search

preference, (page 122, table 4-3, Field 'People').

In reference to claims 10 and 28, Lotus Sametime teaches the method / system

of claims 8 and 26 further comprising:

establishing an order in which said record sources are accessed during said

searching step, (page 120, table 4-2, Field "Position of this server in the search order").

In reference to claims 11 and 29, Lotus Sametime teaches the method / system

of claims 1 and 19 further comprising:

directly executing at least one software-enhanced communication involving said

online entity and a user of said graphical user interface using said search result, (page

9, 1.3.3, 4th and 5th paragraphs).

In reference to claims 12, 30 and 35, Lotus Sametime teaches a method / system

comprising:

receiving a user specified search pattern, (page 125, #'s 11-12);

searching a point of presence database for online entities having access to a

collaboration software application which satisfy said search pattern, (page 3, 1.2.3,

page 126, figure 4-22 and table 4-5);

presenting a list of said resulting online entities, (page 126, 1st paragraph);

receiving a selection of at least one of said resulting online entities contained

within said list, (page 126, 1st paragraph); and

establishing a software-enhanced communication session between said user and

said selected online entity, (page 3, 1.2.3, page 126, figure 4-22 and table 4-5).

In reference to claims 13 and 31, Lotus Sametime teaches the method / system

of claims 12 and 30 further comprising:

displaying a graphical user interface for an instant messaging component of said

collaboration software application, (page 151, figure 5-28),

wherein said graphical user interface provides a user selectable search option;

receiving a user selection for said search option, (page 201); and

responsively presenting search input fields within said graphical user interface,

wherein said search pattern is based upon data input into said search input fields, (page

201, input box).

In reference to claims 14 and 32, Lotus Sametime teaches the method / system

of claims 13 and 31 wherein:

said software-enhanced communication session includes a type of

communication other than instant messaging, (page 150, 5.5 – page 151).

In reference to claims 15 and 33, Lotus Sametime teaches the method / system

of claims 12 and 30 wherein:

said collaboration software application is a Lotus Sametime (TM) type

application, (page 15).

In reference to claim 16, Lotus Sametime teaches a method comprising:

a collaboration server configured to coordinate collaboration operations between

a plurality of geographically disperse software components, (page 9, 1.3.3, 4th

paragraph); and

at least one client side collaboration application that includes a search engine,

said search engine configured to query said collaboration software system for online

entities, (page 121, figures 4-19 and 4-20),

wherein said client side collaboration application contains a graphical user

interface permitting user customization of said search engine, (page 121, figures 4-19

and 4-20).

In reference to claim 17, Lotus Sametime teaches the method / system of claim

16 wherein:

said graphical user interface comprises an instant messenger view and a search

view, (page 201, figure 6-7).

In reference to claim 18, Lotus Sametime teaches the method / system of claim

17 wherein:

said search view is directly initiated from said instant messenger view, and

wherein said search view utilizes said search engine, (page 201, figure 6-7 and item 2).

4.   Claims 1, 3-5, 19 and 21-23 are rejected under 35 U.S.C. 102(e) as being

anticipated by Berger et al., (hereinafter Berger), (US Publication No. 2004/0267887).

In reference to claims 1 and 19, Berger teaches a method / system comprising:

providing a collaborative computing system comprising at least one instant

messaging client, (paragraph 27);

initializing said instant message client within a graphical user interface of said collaborative computing system, (paragraph 28);

receiving a search initializing action from said graphical user interface; responsive to said receiving step, (paragraph 33),

presenting search input fields within said graphical user interface, (paragraph 33);

receiving input via said input fields that specifies a search pattern, (paragraph 33);

searching at least one record source for online entities that satisfy said search pattern, (paragraph 33); and

displaying a search result from said searching step within said graphical user interface, (paragraph 33).

In reference to claims 3 and 21, Berger teaches the method / system of claims 1 and 19 wherein:

said search initializing action comprises at most two user inputs, (paragraph 33).

In reference to claims 4 and 22, Berger teaches the method / system of claims 3 and 21 further comprising:

displaying a menu option within said graphical user interface for said instant message client, wherein said menu option is configured to initiate said search view, (paragraph 33).

In reference to claims 5 and 23, Berger teaches the method / system of claims 3 and 21 further comprising:

providing a keyboard combination to initiate said search view, whereby said keyboard combination is a hot-key combination, (paragraph 35, 'or selecting a designated key from the data processing device's keyboard').

Conclusion

5.   The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William J. Goodchild whose telephone number is (571) 270-1589. The examiner can normally be reached on Monday - Friday / 9:00 AM - 5:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jason Cardone can be reached on (571) 272-3933. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

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WJG
07/10/2007

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